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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,994	11/25/2003	Martin Newman	0EKM-108414	7981
30764	7590	09/19/2005	EXAMINER	
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 333 SOUTH HOPE STREET 48TH FLOOR LOS ANGELES, CA 90071-1448			CHAMBERS, MICHAEL S	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TJL

<b>Office Action Summary</b>	<b>Application No.</b> 10/723,994	<b>Applicant(s)</b> NEWMAN ET AL.	
	<b>Examiner</b> Mike Chambers	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 20-25 and 27-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 20-25 and 27-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al (6007434). Baker discloses the elements of claim 1, however it fails to clearly disclose a spaced apart distance of at least 0.1mm and a volume of less than 0.0007 mm<sup>3</sup>. The applicant has disclosed these limitations as a preferred embodiment but the specification does not disclose any unexpected or surprising results from using these limitations. It would have been obvious to have a spacing of at least 0.1mm and a shape volume of less than .0007mm<sup>3</sup> in order to have a coefficient of friction preferred by a player due to his specific swing and impact on a ball. Also, it would have been obvious one of ordinary skill in the art at the time of the invention to have employed the any one of several equivalent geometric designs based on cost and design considerations.

As to claim 2 : Baker discloses geometric shapes. The specification provides no unexpected results in having a total volume of less than 0.02mm<sup>3</sup>. It would have been obvious to have a spacing of at least 0.1mm and a shape volume of less than .02mm<sup>3</sup> in order to have a coefficient of friction preferred by a player due to his specific swing and impact on a ball. Also, it would have been obvious to one of ordinary skill in the art

to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claims 3 and 4 : Baker discloses geometric shapes. The area disclosed in fig 2 would be less than 15%. The specification provides no unexpected results in having a total volume of less than 15%. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 5 : Baker discloses geometric shapes. The specification provides no unexpected results in having a total volume of less than 0.0003mm<sup>3</sup>. It would have been obvious to have a spacing of at least 0.1mm and a shape volume of less than .0003mm<sup>3</sup> in order to have a coefficient of friction preferred by a player due to his specific swing and impact on a ball . It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape and volume based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 6 : Baker discloses geometric shapes having the same shape and size (fig 2).

As to claim 7 : Baker discloses a plurality of grooves (fig 1- item 16a).

As to claim 25 : Baker discloses a plurality of first and second shapes (fig 2).

As to claim 27. : Baker discloses geometric shapes. The specification provides no unexpected results in having more than one orientation. It would have been obvious to one of ordinary skill in the art to have selected an appropriate design and orientation based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 28 : Baker discloses geometric shapes. The specification provides no unexpected results in having a forward striking face that is less than 0.05 mm<sup>2</sup>. It would have been obvious to have a spacing of at least 0.1mm and a shape volume of less than .0007mm<sup>3</sup> in order to have a coefficient of friction preferred by a player due to his specific swing and impact on a ball . Also, it It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker as applied to claim1 above, and further in view of Official Notice. Official Notice is taken that it is well known in the art to welding to attach the members. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent attachment means based on cost and design considerations.

As to claim 21 : Baker discloses a club with the front wall and sole integrally formed with each other (fig 1).

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker as applied to claim1 above, and further in view of Official Notice. Official Notice is taken that the loft angles cited are well known in the art. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent lofts based on cost and design considerations and to increase the player satisfaction with the device.

As to claims 29-39: See claims 1-7,25, 27 and 28 rejections. These claims are merely slight variations of the previous claims and represent the same invention.

Also,

Claims 1-4,6,7,25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinnon (6110057). McKinnon discloses the elements of claim 1, however it fails to clearly disclose a spaced apart distance of at least 0.1mm and a volume of less than 0.0007 mm<sup>3</sup>. The applicant has discloses these limitations as a preferred embodiment but the specification does not disclose any unexpected or surprising results from using these limitations therefore they are obvious design choices. It would have been obvious to have a spacing of at least 0.1mm and a shape volume of less than .0007mm<sup>3</sup> in order to have a coefficient of friction preferred by a player due to his specific swing and impact on a ball . Also, it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the any one of several equivalent geometric designs based on cost and design considerations.

As to claim 2 : McKinnon discloses geometric shapes. The specification provides no unexpected results in having a total volume of less than 0.02mm. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claims 3 and 4 : McKinnon discloses geometric shapes. The area disclosed in fig 3 would be less than 15%. The specification provides no unexpected results in having a total volume of less than 15%. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 6 : McKinnon discloses geometric shapes having the same shape and size (fig 3).

As to claim 7 : McKinnon discloses a plurality of grooves (fig 5).

As to claim 25 : McKinnon discloses a plurality of first and second shapes (fig 4).

As to claim 28 : McKinnon discloses geometric shapes. The specification provides no unexpected results in having a forward striking face that is less than 0.05 mm<sup>2</sup>. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinnon as applied to claim 1 above, and further in view of Official Notice. Official Notice is taken that it is well known in the art to weld to attach the members. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent attachment means based on cost and design considerations.

As to claim 21 : McKinnon discloses a club with the front wall and sole integrally formed with each other (fig 1).

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinnon as applied to claim 1 above, and further in view of Official Notice. Official Notice is taken that the loft angles cited are well known in the art. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent

lofts based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 27 : McKinnon discloses geometric shapes. The specification provides no unexpected results in having more than one orientation. It would have been obvious to one of ordinary skill in the art to have selected an appropriate design and orientation based on cost and design considerations and to increase the player satisfaction with the device.

As to claims 29-39: See claim 1-4, 6,7,20-25, 27 and 28 rejections. These claims are merely slight variations of the previous claims and represent the same invention.

Also,

Claims 1-4,6,7, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miesch et al (4964641). Miesch discloses the elements of claim 1, however it fails to clearly disclose a spaced apart distance of at least 0.1mm and a volume of less than 0.0007 mm<sup>3</sup>. The applicant has discloses these limitations as a preferred embodiment but the specification does not disclose any unexpected or surprising results from using these limitations therefore they are obvious design choices. It would have been obvious to have a spacing of at least 0.1mm and a shape volume of less than .0007mm<sup>3</sup> in order to have a coefficient of friction preferred by a player due to his specific swing and impact on a ball . Also, it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the any one of several equivalent geometric designs based on cost and design considerations.



As to claim 2 : Miesch discloses geometric shapes. The specification provides no unexpected results in having a total volume of less than 0.02mm. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claims 3 and 4 : Miesch discloses geometric shapes. The area disclosed in fig 4 would be less than 15%. The specification provides no unexpected results in having a total volume of less than 15%. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 6 : Miesch discloses geometric shapes having the same shape and size (fig 1).

As to claim 7 : Miesch discloses a plurality of grooves (fig 1).

As to claim 28 : Miesch discloses geometric shapes. The specification provides no unexpected results in having a forward striking face that is less than 0.05 mm<sup>2</sup>. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miesch as applied to claim1 above, and further in view of Official Notice. Official Notice is taken that it is well known in the art to welding to attach the members. It would have

been obvious to one of ordinary skill in the art to have selected any one of several equivalent attachment means based on cost and design considerations.

As to claim 21 : Miesch discloses a club with the front wall and sole integrally formed with each other (fig 1).

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miesch as applied to claim 1 above, and further in view of Official Notice. Official Notice is taken that the loft angles cited are well known in the art. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent lofts based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 27 : Miesch discloses geometric shapes. The specification provides no unexpected results in having more than one orientation. It would have been obvious to one of ordinary skill in the art to have selected an appropriate design and orientation based on cost and design considerations and to increase the player satisfaction with the device.

As to claims 29-39: See claim 1-4, 6,7,20-24, 27 and 28 rejections. These claims are merely slight variations of the previous claims and represent the same invention.

Also,

Claims 29-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowland et al (5688190). Rowland discloses the elements of claim 29, however it fails to clearly disclose a spaced apart distance of at least 0.1mm and a volume of less than

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0.0007 mm<sup>3</sup>. The applicant has disclosed these limitations as a preferred embodiment but the specification does not disclose any unexpected or surprising results from using these limitations therefore they are obvious design choices. It would have been obvious to have a spacing of at least 0.1mm and a shape volume of less than .0007mm<sup>3</sup> in order to have a coefficient of friction preferred by a player due to his specific swing and impact on a ball. Also, it would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the any one of several equivalent geometric designs based on cost and design considerations.

As to claim 30 : Rowland discloses geometric shapes (fig 9). The specification provides no unexpected results in having a total volume of less than 0.005mm<sup>3</sup>. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape and volume based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 31 : Rowland discloses geometric shapes (fig 9). The specification provides no unexpected results in having a total volume of less than 0.0003mm<sup>3</sup>. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape and volume based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 32 : Rowland discloses geometric shapes. The specification provides no unexpected results in having a forward striking face that is less than 0.05 mm<sup>2</sup>. It would have been obvious to one of ordinary skill in the art to have selected an

appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 33 : Rowland discloses plurality of scorelines (fig 9).

As to claim 34 : Rowland discloses geometric shapes. The specification provides no unexpected results in having a forward striking face that is less than 0.02 mm<sup>2</sup>. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 35 : Rowland discloses geometric shapes (fig 9, 4:16-20,4:48-52, 4:65-5:2). The specification provides no unexpected results in having an individual volume of less than 0.003mm and combined volume of less than 0.02 mm<sup>3</sup>. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 36 : Rowland discloses geometric shapes that are about identical in size and shape (fig 9).

As to claim 37 : Rowland discloses geometric shapes that are spaced substantially evenly (fig 9).

As to claims 38 and 39: Rowland discloses geometric shapes and first and second shapes (fig 1, 9, 15). The specification provides no unexpected results in having the geometric shapes in the form of squares, circles or diamonds. This is considered an artistic design choice. It would have been obvious to one of ordinary skill in the art to

have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

### ***Response to Arguments***

Applicant's arguments filed 8/26/05 have been fully considered but they are not persuasive. The applicant argues that the cited art does not disclose the instant invention. The applicant then goes to great lengths in an attempt to show that the pyramids of Miesh et al have a greater volume than the current claims call for. Since the current claim language merely calls for one engineering textured surface to be spaced apart from the next with no reference point for where the separation is to take place, one can merely move up the geometric shape until the parameters of the claims are met.

But taking a different point of discussion, the applicant has failed to show in the specification or response why the claimed limitations are critical to the instant invention; therefore they are considered design choices. For example the specification fails to show that the result of hitting a golf ball would be any less if the volume of the engineered texture were greater than 0.0007mm<sup>3</sup> or the distance between the textures were less than 0.1mm. There is no unanticipated or surprising results from the claimed limitations, therefore they are considered artistic design choices and obvious variations of the cited art.

***Conclusion***

Note: The specification fails to clearly disclose what the applicant believes the novelty of the invention is. Although the specification has provided some design considerations, the examiner fails to see how the instant invention avoids obvious design choices based on cost and design considerations.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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September 15, 2005

Michael Chambers  
Examiner  
Art Unit 3711

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**